UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER COLLINS

Appeal No. 2006-0895
Application No. 09/902,515

ON BRIEF

Before BARRY, BLANKENSHIP and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-12, 14-16 and 22-29. Claims 13 and 17-21 have been withdrawn from consideration as being drawn to a non-elected invention.

We affirm.

BACKGROUND

Appellant's invention is directed to data compression techniques used for transmitting data over a bandwidth-limited network. According to Appellant, first and second fields within a message are identified and different sets of code words are applied to each field to encode data in each field (specification, page 5). An understanding of the invention can be derived from a reading of exemplary independent claim 1 which is reproduced as follows:

1. A method comprising:

identifying a first field and a second field within an electronic mail (email) message;

applying a first set of code words to encode data in said first field; and

applying a second set of code words to encode data in said second field.

The Examiner relies on the following references in rejecting the claims:

Carr	5,293,379	Mar. 8, 1994
Unger et al. (Unger)	5,991,713	Nov. 23, 1999
Ackley	6,422,476	Jul. 23, 2002 (filed Aug. 17, 1999)

Claims 1, 4, 5, 9, 12, 14, 22, 25 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Carr.

Claims 2, 3, 10, 11, 16, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carr and Unger.

Claims 6-8, 15 and 27-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carr, Unger and Ackley.

Rather than reiterate the opposing arguments, reference is made to the brief and answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the brief have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

35 U.S.C. § 102 Rejection of claims 1, 4, 5, 9, 12, 14, 22, 25 and 26

In rejecting the claims, the Examiner reads the claimed first and second field within an email on the header and the text of an email as taught by Carr (answer, page 4). Regarding claims 1 and 22, Appellant argues that Carr merely discloses static and dynamic fields within a data packet (brief, page 6) and has nothing to do with an email message nor the first and second fields within that email message (brief, page 7). In response, the Examiner asserts that the transmitted data in Carr are email messages since they are transmitted over a communication network (answer, page 10). The Examiner further argues that such

messages are taught by Carr to have different fields containing destination address and source address which are later compressed according to two different compression dictionary tables (answer, pages 10-11).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Carr clearly discloses using different dictionary tables for compression of user data or the header portion of a data packet and for compression of the dynamic field data which may change with each data packet (col. 7, lines 4-13 and 39-46). Although we agree with Appellant that the data sent over the network of Carr include data packets, we do not find that the Examiner has made any error in reading the claims over the compression techniques of Carr as applied to two different fields in the transmitted data packets. It is the header and the dynamic content of the transmitted data packets which, when taken as a whole, indicate that the data packets of Carr are the same as the

email messages defined by the claims. Since most transmitted data including email messages, once considered at the machine level, are sent as data packets, the disclosure of Carr would include applying different compression methods to two different fields within an email. Therefore, although Carr describes transmitting data packets between different computers, at a higher level, such data packets correspond to specific forms of data such as emails and other types of messages. This position is consistent with Appellant's disclosure specifying the application of different code words to a message in order to encode the data in each field (specification, pages 5, 21 and 22).

Therefore, we find the Examiner's reading the first and the second fields within the data packets recited in claims 1 and 22 on the compression of the data packets of Carr to be reasonable and consistent with the reference disclosure and Appellant's specification analyzed above. Accordingly, the 35 U.S.C. § 102 rejection of claim 1, as well as claims 4, 5, 22, 25 and 26 argued together as one group, over Carr is sustained.

With respect to the rejection of claim 9, Appellant presents arguments related to the presence of the first and the second fields within an email message which are similar to the arguments addressed above with respect to claim 1. Therefore, as Carr

discloses all the claimed limitations, the anticipation rejection of claims 9, 12 and 14 over Carr is also sustained.

35 U.S.C. § 103 Rejection of claims 2, 3, 6-8 10, 11, 15, 16, 23, 24 and 27-29

With respect to the remaining claims, the Examiner further relies on Unger and Ackley while Appellant's arguments in support of patentability of these claims include assertions similar to those addressed above with respect to claims 1, 9 and 22. Considering the arguments presented and addressed above, we find the Examiner's position to be sufficiently reasonable to support a prima facie case of obviousness. Therefore, the 35 U.S.C. § 103 rejection of claims 2, 3, 10, 11, 16, 23 and 24 over Carr and Unger and of claims 6-8, 15 and 27-29 over Carr, Unger and Ackley is sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 4, 5, 9, 12, 14, 22, 25 and 26 under 35 U.S.C. § 102 and claims 2, 3, 6-8, 10, 11, 15, 16, 23, 24 and 27-29 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

LANCE LEONARD BARRY Administrative Patent Judge	)
HOWARD B. BLANKENSHIP Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)

MS/rwk

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